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P.C.H.
6-2-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Donald Arthur Reynolds
Appl. No. : 09/486,875
Filed : May 8, 2000
Title : GASKET FOR CLADDING SYSTEM

Grp./A.U. : 1732
Examiner : G. Shippersides

Docket No. : 65,008-018

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BRIEF ON APPEAL

Applicant submits the following arguments in support of this appeal in response to the Final Rejection set forth in the Official Action dated **January 28, 2003**.

(1) Real Party in Interest

This application was assigned by the inventors to *SD Investments Limited* as evidenced by the assignment recorded at reel **010818**, frame **0548**.

(2) Related Appeals and Interferences

NONE

(3) Status of Claims

The independent claims **1, 9, 11** and **12** are on appeal and are attached hereto in the appendix.

(4) Status of Amendments

All amendments have been entered and are reflected in the claims in the

Attorney Docket: 65,008-018

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Appendix.

(5) Summary of Invention

A method of forming a joint between two plastic extrusions of solid material having front and rear surfaces comprising the steps of mitring the extrusions (10) at mitred ends (22) so that they form the desired angle to one another at the mitred ends. The method is distinguished by removing solid portions of the rear surface of each extrusion along a line (30) at the mitred ends behind the front surfaces (24) to maintain the integrity of the front surfaces at the mitred ends. The mitred extrusions are disposed in a mold to form a mitred joint with the front surfaces (24) abutting one another at the mitred joint to inject a plastic material (32) into the mold along the line (30) to rebuild the removed portion with a solid plastic material and bond the extrusions together across the mitred joint beneath the front surfaces (24).

The importance is that the entire front surface of the mitred ends are maintained thereby overcoming problems with color matching or site lines as mentioned on page 2 of the specification. It is important that the injected material defines a solid as distinguished from a hollow member.

(6) Issues

As to the 35 U.S.C. 112 rejections:

1. Whether the recitation “with solid material between said surfaces” is supported by the original application where it is described and clearly shown at 32 in

Figures 4-6;

2. Whether the recitation “along a line” is supported by the original application where it is described and clearly shown at 30 in Figures 4 and 5.

As to the 35 U.S.C. 103 rejections:

1. Whether it would be obvious to modify the Wain ‘849 patent that injects the front surface (88) of the mitred ends in view of the Eagles ‘962 patent wherein a block of material (24) reinforces hollow extrusions (19).

(7) Grouping of Claims

Claims 1, 9, 11 and 12 are grouped together to stand or fall together.

(8) Argument

A. The 35 U.S.C. 112 Rejections

All of the claims are rejected “as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.”

This broad assertion is factually inaccurate because the application originated from the United Kingdom and it was the undersigned attorney who discerned the rejected language from the entire description. In other words, the subject matter was reasonably conveyed to the undersigned attorney, one of less ability in understanding such things

than one skilled in the art.

Claim 1 was specifically rejected on the basis that the “original disclosure does not provide literal or inherent support for the limitation of ‘with solid material between said surfaces’ “. It is clear from the overall description that the solid part removed or cutaway is rebuilt by the solid injected portion. As shown in Figure 4, the line 30 really defines a plane cutting under the corner. Accordingly, the extrusions, as clearly shown in Figure 5, are solid between the front and rear surfaces, i.e., the part cut-away is solid and the injected replacement is solid as shown at 32 in Figure 5.

Claims 9, 11 and 12 were specifically rejected on the basis that “injecting a plastic material into the mold **along the line** to rebuild the removed portion” is new matter and is not sufficiently set forth in the specification to enable one skilled in the art to make and/or use the invention.

As explained in lines 9 et seq. of page 4 of the specification “the back of each extrusion 10 is cut away **along a line 30** Thus, the front faces 24 are left untouched.” (bold added) The description, on page 4, line 13, recites that the “butt joined cut-away extrusions are then put into a mould . . . and injected with a suitable resin 32, . . .” It is clear that the extrusions are cut along the line 30 and that the injected plastic is deposited along the same line 30. The method described clearly includes cutting away only the back along a line and injecting material to rebuild the back behind the front surfaces to retain the integrity of the front surfaces. The undersigned attorney understood this from reading the application, a judge and jury would understand this, and certainly a man skilled in the art would understand this.

The reversal of the rejections under 35 U.S.C. 112 is respectfully solicited as unwarranted for not giving full understanding to an adequate description. country.

B. The 35 U.S.C. 103 Rejections

The examiner admits that Wain ‘ 849 does not teach a finished joint where the front surfaces remain intact. The examiner goes on to state that Eagles ‘962 teaches a similar process wherein the underside is removed to facilitate a molding operation. However, Eagles ‘962 does not employ a molding process. In contradistinction, Eagles ‘962 discloses the cutting away of walls 20 and 21 in a hollow extrusion and thereafter inserting a preformed block 24. Applicant is not the first to mitre and connect such parts, but applicant has invented a specifically different method for joining such extrusions. Neither reference suggests applicant’s method of cutting away only the back along a line and injecting material to rebuild the back behind the front surfaces to retain the integrity of the front surfaces.

The teachings of Wain ‘849 are no better than the prior art teachings of Figures 1 and 2 of the subject application in that both cut away the front surfaces. Eagles ‘962 does not cut away a solid back and does not inject plastic to rebuild the solid back. There is no reason outside of applicant’s teaching to modify either of the references.

The law is adequately set forth in the MPEP:

**2143.03 All Claim Limitations Must Be Taught or
Suggested [R-1]**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**2142 Legal Concept of *Prima Facie*
Obviousness [R-1]**

. . . The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness . . .

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §243 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter,

either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

First, the Examiner states that one skilled in the art could not practice the invention in the words used to claim the invention then turns around and states that the same invention would be obvious to that same skilled artisan. These are inconsistent positions. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references as suggested by the Examiner. In order for the rejection to stand there must be a reasonable expectation of success in the combination the examiner suggests. It is respectfully submitted that the Eagles strips could not be placed in a mold to receive injected plastic because the plastic would run freely down the hollow extrusions. That is why it is important that the extrusions be solid as set forth in the claims. Finally, the prior art references when combined do not teach or suggest all the claim limitations; to wit, the extrusions are not cut away along a line as claimed. It is respectfully submitted that the teaching or suggestion to make the claimed combination and the reasonable expectation of success are not both found in the prior art, but are based only on applicant's disclosure.

Examiner
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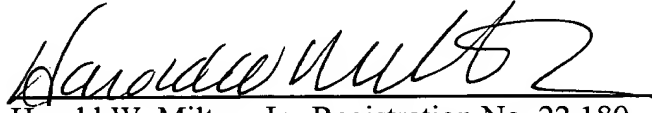
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The reversal of the examiner's rejection under 35 U.S.C. 103 is respectfully solicited.

Respectfully submitted

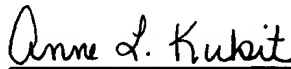
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CERTIFICATE OF MAILING

I hereby certify that the attached Appeal Brief for application serial number 09/486,875 filed May 8, 2000 is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, Virginia 22313-1450, Mailstop: Appeal Briefs-Patents, on this **May 21, 2003**.



Anne L. Kubit

(9) Appendix

1. A method of forming a joint between two plastics extrusions having front and rear surfaces with solid material between said surfaces comprising; mitring the extrusions so they form the desired angle to one another at a mitre joint, removing a solid part of the rear face of each extrusion behind said front surfaces while maintaining the integrity of said front surface of each extrusion, placing the mitred extrusions in a mould and injecting a resin material to restore the solid shape and bond the extrusions to one another across the mitred joint beneath the front surfaces and produce the desired joint configuration whereby the front surface of the joint is entirely defined by the front surfaces of the mitred extrusions.

9. A method of forming a joint between two plastic extrusions of solid material having front and rear surfaces comprising the steps of;

mitring the extrusions at mitred ends so that they form the desired angle to one another at the mitred ends,

removing solid portions of the rear surface of each extrusion along a line at the mitred ends behind the front surfaces to maintain the front surfaces to maintain the integrity of the front surfaces at the mitred ends,

placing the mitred extrusions in a mold to form a mitred joint with the front surfaces abutting one another at the mitred joint,

injecting a plastic material into the mold along the line to rebuild the removed portion with a solid plastic material and bond the extrusions together across the mitred joint beneath the front surfaces.

11. A method as set forth in claim 9 including at least one sealing lip on the rear surface and injecting the plastic material into the mold to form a continuation of the sealing lip between the extrusions.

12. A method as set forth in claim 9 including male foot portions for insertion into a channel to retain the extrusions to a structure and injecting the plastic material into the mold to form at least one extension of the foot portions.